

Remarks

This Paper is filed in response to the Office Action dated March 16, 2006.

The Office Action mailed on March 16, 2006 subjects claims 1-20 currently pending in the present Application to a restriction requirement and sets a three month shortened statutory period to reply. The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

- Group I: Claims 1, 3-10 and 12-18, drawn to a method of heat treating a titanium article, classified in class 148, subclass 671.
- Group II: Claims 2 and 11, drawn to a method of heat treating a titanium article in combination with a method of casting from melt, classified in class 148, subclass 538.
- Group III: Claims 19-20, drawn to a titanium article, classified in class 148, subclass 421.

Applicant traverses the restriction requirement.

Inventions II and I

The Examiner stated that the inventions are distinct, each from the other because of the following reasons, specifically stating:

"Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combination (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that water quenching is initiated within about 20 seconds of completing the step of solution heat

treating. The subcombination has separate utility such as a method for fabrication a sintered and heat-treated titanium-alloy article."

The argument for the restriction is based upon the assertion that "the combination [Invention II] does not require that water quenching is initiated within about 20 seconds of completing the step of solution heat treating." Nor does the subcombination [Invention I]. The limitation regarding 20 seconds is not found in the independent claims. Claim 1 recites "water quenching the gas turbine engine component to room temperature," with no limitation involving 20 seconds. Claim 10 has a similar recitation. Thus, the two-way requirement is not met, and the restriction is not proper.

#### Inventions I and III

The Examiner stated that the inventions are distinct, each from the other because of the following reasons, specifically stating:

"Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by water quenching the gas turbine component to a temperature above room temperature."

The first two paragraphs on page 3 of the Office Action are identical. Applicant does not know if there was an intent to have a different paragraph and it was left out, or whether the single paragraph was unintentionally repeated.

The argument is made that "In the instant case the product can be made by water quenching the gas turbine component to a temperature above room temperature." Applicant respectfully disagrees--the product of claim 19, for example, can only be made by the process of claim 1, because claim 19 recites: "19. A forged titanium alloy article made from the process of claim 1." Claim 1 recites in part: "water quenching the gas turbine engine component to room temperature." [emphasis added] If the process is altered so that the gas turbine engine component is quenched to a temperature above room temperature, as argued in the restriction, it is no longer the article recited in claim 19.

A similar position holds for claim 20 and its parent claim 10.

Furthermore, there is no undue burden placed on the patent office by examining all of the claims of Groups I, II and III. To conduct a proper examination of the claims of any Group, the art relating to all of the groups must be searched to meet the thoroughness requirement of the rules. The rules provide:

"On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated." [37 CFR 1.104(a)].

There has been no showing that a search of the art relating to all the groups would pose a serious burden on the Examiner, and all should be searched. MPEP 803 states:

"If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." [Emphasis added]

Given that 37 CFR 1.104(a) mandates a thorough examination, which would presumably include searching in art related to all groups, the mandate of MPEP 803 requires that all groups be examined. If the restriction is maintained, Applicant asks that the Examiner demonstrate why a search of art related to all groups would pose a serious burden, and in fact why the art related to all groups should not be searched to meet the thoroughness requirement. Applicant wants a thorough search of its invention, and is concerned that the search may be less than thorough if certain search areas are arbitrarily excluded for restriction reasons.

For at least these reasons, Applicant asks that the Examiner withdraw the restrictions, and examine claims 1-20.

Notwithstanding the foregoing and in order to comply with the restriction requirement, Applicant provisionally elects, with traverse, the inventions of Group I, claims 1, 3-10, and 12-18, drawn to a method of heat treating a titanium article, classified in class 148, subclass 671.

This Response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicant is mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Dated: May 19, 2006

Respectfully submitted,  
McNees Wallace & Nurick LLC

Phone: (717) 237-5218  
Fax: (717) 237-5300

/Shawn K. Leppo/  
Shawn K. Leppo  
Reg. No. 50,311  
100 Pine Street  
P.O. Box 1166  
Harrisburg, PA 17108-1166